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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,080	09/19/2001	Kenji Yamaguchi	213672US2	9701
22850	7590	06/25/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PIZARRO CRESPO, MARCOS D	
			ART UNIT	PAPER NUMBER
			2814	

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,080

Applicant(s)

KENJI YAMAGUCHI, ET AL.

Examiner

Marcos D. Pizarro-Crespo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1. ☒ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Attorney's Docket Number: 213672US2

Filing Date: 9/19/2001

Claimed Foreign Priority Date: 5/19/2001 (JP P2001-138712)

Applicant(s): Kenji Yamaguchi, et al.

Examiner: Marcos D. Pizarro-Crespo

DETAILED ACTION

This Office action responds to the election in paper no. 8 filed on 4/9/2004.

Election/Restrictions

1. Applicant's election of the invention specified in paper no. 7 as species 1, reading on figure 6, and including claims 7-11, is acknowledged. The applicants have failed to advance reasons leading to the conclusion that the species claimed are considered clearly unpatentable over each other. Because the applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-6 and 12-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected invention, there being no allowable generic or linking claim.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

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Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

4. Claim 8 is rejected under 35 U.S.C. 112, fourth paragraph, as being (an) improper dependent claim(s) for failing to include every limitation of the claim(s) from which it depends. Applicant is required to cancel or amend the claim to place the claim in proper dependent form, or to rewrite the claim in independent form.

5. The limitations in claim 8 infringe the limitations in basic claim 7. Whereas claim 7 describes that the calculation section uses the effective channel length, L_{eff} , claim 8 recites that the calculation section uses a design gate length, L_d , instead of L_{eff} . Claim 7 includes L_{eff} while claim 8, on the other hand, excludes L_{eff} to include L_d .

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Yamaguchi (JP 2000-068508).

9. Regarding claims 7-10, Yamaguchi shows (see, e.g., fig. 8) a semiconductor device evaluation apparatus **1** comprising:

- A calculation section **6**
- A control section **4**
- A first determination section **11** controlled by the control section **4**
- A second determination section **13** controlled by the control section **4**
- A third determination section **14** controlled by the control section **4**

As to the grounds of rejection under section 103(a), the limitations in claims 7-10 with respect to the manner in which the semiconductor device evaluation apparatus is intended to be used does not differentiate the claimed apparatus from that of Yamaguchi since Yamaguchi shows all the structural limitations recited in the claims. See MPEP § 2112 which discusses the handling of apparatus claims claimed in terms of function and recommends the alternative (§ 102 / § 103) grounds of rejection. **Note that Applicant has burden of proof in such cases**, as the MPEP makes clear.

Conclusion

10. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. Papers should be faxed to Art Unit 2814 via the Art Unit 2814 Fax Center. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center

number is **(703) 872-9306**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Marcos D. Pizarro-Crespo** at **(571) 272-1716** and between the hours of 9:30 AM to 8:00 PM (Eastern Standard Time) Monday through Thursday or by e-mail via Marcos.Pizarro@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on (571) 272-1705.

12. Any inquiry of a general nature or relating to the status of this application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LONG PHAM
PRIMARY EXAMINER

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13. The following list is the Examiner's field of search for the present Office Action:

Field of Search	Date
U.S. Class / Subclass(es): 324/71.1,658,661,662,671,716,719,765-769;257/48	6/17/04
Other Documentation: PLUS Analysis	6/17/04
Electronic Database(s): EAST (USPAT, EPO, JPO, PGPub)	6/17/04

Marcos D. Pizarro-Crespo

Patent Examiner

Art Unit 2814

571-272-1716

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